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**CHICAGO IL 60606-1080**

**MAILED**

**SEP 01 2009**

In re Patent No. 6,767,668 :  
Issue Date: July 27, 2004 :  
Application No. 09/803,685 :  
Filed: March 9, 2001 :  
Attorney Docket No. 09792909-4804 :

**OFFICE OF PETITIONS**

**ON PETITION**

This is a decision on the petition under 37 CFR 1.378(c), filed on December 8, 2008, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b).

This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f). The petition for reconsideration must include the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks item (1) listed above.

Petitioner asserts: (1) "On December 1, 2005, Sony Corporation, informed its U.S. Patent counsel, David R. Metzger and SONNENSCHEIN NATH & ROSENTHAL LLP, to not maintain the patent."; (2) A declaration by Chisato Numaoka filed with the instant petition states: "However, during July to August, 2008 I was tasked with the responsibility of reviewing a large number of Sony Corporations patents to again determine which patents should be maintained. I had full authority to decide on behalf of

Sony Corporation which patents should be maintained. My decision was to be final, subject only to ministerial approval for things like funding. I did not know when any fees for maintaining the patents were due.”; (3) “By July 27, 2008, I determined that United States Patent No. 6,767,668 should be maintained. My decision to maintain the ‘668 patent constituted an intention on behalf of Sony Corporation to maintain the ‘668 patent. I acted with full and proper authority within the Intellectual Property Division to identify the ‘668 patent as a patent to be maintained.”; (4)”As a result, Sony Corporation by virtue of my full and complete authority to act on behalf of Sony Corporation, made a deliberate decision to maintain U.S. Patent No. 6,767,668 before July 27, 2008.”; and (5) “Unfortunately, due to the large number of patents being reviewed, the entire task could not be completed until end of August, 2008. Further, due a need to obtain approval for the funding of the payment of the maintenance fees, the decision to maintain the ‘668 was not communicated to Sony’s United States patent counsel, David R. Metzger, Sonnenschein Nath & Rosenthal LLP, until November, 4, 2008.”

Petitioner has failed to meet his burden of establishing that the delay in payment of the maintenance fee was unintentional within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(a), (c).

The showing of record is that the delay resulting in the expiration of this patent is due to an intentional decision by a responsible party, Sony Corporation, to not continue this patent in force, but rather, to permit the expiration of the patent by deliberately withholding the maintenance fee. This course of action, deliberately chosen, cannot reasonably be considered to have been unintentional within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c).

A delay caused by the deliberate decision not to take appropriate action within a statutorily prescribed period does not constitute an unintentional delay within the meaning of 35 U.S.C. § 41. In re Application of G, 11 USPQ2d 1378,1380 (Comm'r Pat. 1989). Such intentional action or inaction precludes a finding of unintentional delay. In re Maldaque, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

The showing of record is that, when the maintenance fee was due there was no compelling reason to continue this patent in force. Petitioner asserts that a decision was made, on July 27, 2008, prior to the ministerial act of obtaining funding to maintain the patent. Despite petitioner's contention to the contrary it is not the decision of July 27, 2008 that must be relied upon to determine whether or not the patent expired unintentionally, rather, it is the decision on December 1, 2005 to not maintain the patent which caused expiration of the patent. This intentional act cannot be overcome by the decision by the party responsible for paying the fee due to now pay the fee and keep the patent in force which occurred on or about November 4, 2008, which is a decision after the expiration of the patent, to pay the maintenance fee due.

The discovery of additional information after making a deliberate decision to withhold a timely action is not the “mistake in fact” that might form the basis for acceptance of a maintenance fee pursuant to 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(c), under the

reasoning of Malague. The discovery of additional, other information is simply a change in circumstances that occurred subsequent to the expiration of the patent. That such other additional information was discovered subsequent to the expiration of this patent does not cause the delay resulting from the previous deliberate decision to become "unintentional" Id.

If this petition is not renewed or if renewed and not granted, then petitioner may request a refund of the maintenance and surcharge fees paid. The fee for requesting reconsideration is not refundable.

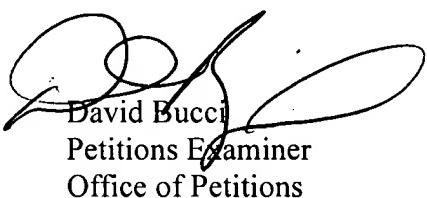
Further correspondence with respect to this matter should be addressed as follows:

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